

REMARKS/ARGUMENTS

Claim 23 has been amended. Claims 30, 32, and 33 have been cancelled, without prejudice, in this amendment. Support for the amendment to claim 23 can be found in Applicants' specification at, for example, page 15, line 28 to page 18, line 27. No new matter has been added.

The Office Action dated September 10, 2003 ("the Office Action") indicates that claims 1-36, 38, 39, and 44 are pending in the above-identified patent application. However, since the amendments filed on June 16, 2003, have been entered, only claims 23-36 and 38-39 are pending.

In view of the remarks to follow, Applicants request that the rejections of record be reconsidered and withdrawn.

Rejections Under 35 U.S.C. § 102(b)

Claims 23-36 and 38-39 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,883,237 to Stec et al. ("the Stec patent"), U.S. Patent No. 5,506,212 to Hoke et al. ("the Hoke patent"); and U.S. Patent No. 5,852,188 to Cook ("the Cook patent")¹. Applicants respectfully traverse this rejection because none of the cited references disclose each and every element of the claimed inventions.

Applicants' claimed inventions relate to gapped oligomeric compounds ("gapmers") that

¹ Applicants reiterate that, although the instant rejection is one made under 35 U.S.C. § 102(b), the Cook patent is not available as prior art against the instant application under 35 U.S.C. § 102(b). In particular, the instant application has a filing date of at least November 12, 1999, whereas the Cook patent became available to the public on December 12, 1998, less than one year before the instant application was filed. Accordingly, the Cook patent is not a 35 U.S.C. § 102(b) reference.

have, *inter alia*, a region of chiral Rp deoxyphosphorothioate internucleoside linkages that is flanked by regions having linkages that are not chiral Rp deoxyphosphorothioate linkages. In contrast, none of the cited references disclose compounds having three such regions. The Stec patent, for example, discloses oligomeric compounds having only one type of linkage (see, e.g., col. 7, lines 14-67). Similarly, the Office Action fails to identify any disclosure of the claimed compounds in the Hoke and Cook patents. For example, claim 2 of the Hoke patent (to which the Office Action refers) does not specify the arrangement of the recited Rp linkages, much less Applicants' claimed arrangement. Although the Office Action alleges that the claimed compounds are disclosed in the Cook patent at col. 5, line 45 to col. 7, no such disclosure is provided. Significantly, the above-noted portions of the Hoke and Cook patents refer to the *percentage* of Rp linkages to be used, but do not specify their *arrangements*. Accordingly, there can be no anticipation. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ.2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

Rejection Under 35 U.S.C. § 103

Claims 23-36 and 38-39 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Cook patent in combination with U.S. Patent No. 5,532,130 to Alul ("the Alul patent"). Applicants respectfully request that this rejection be withdrawn, as there is no evidence of record indicating that those of ordinary skill would have been motivated to combine the teachings of the Cook and the Alul patents, or even that such combination would have resulted in one of Applicants' claimed inventions. As discussed above for example, the Cook patent does not disclose compounds having a region of chiral Rp deoxyphosphorothioate

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internucleoside linkages that is flanked by regions having linkages that are not chiral Rp deoxyphosphorothioate linkages. The Alul patent does not remedy this deficiency, nor has it been alleged to do so. Thus, combination of the Cook and Alul patents would not have resulted in any claimed invention. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are respectfully requested.

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Applicants respectfully submit that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested.

Respectfully submitted,



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